

invention. Claims 1-10 and 12 stand rejected. By this amendment, claim 1 is amended and claim 10 is canceled without prejudice. The Office Action is non-final.

Reconsideration based on the following amendments and remarks is respectfully requested.

Election/Restrictions

Applicant acknowledges the withdrawal of claims 11 and 13-17 as being drawn to a non-elected invention but reserves the right to pursue the withdrawn claims in a divisional application.

Claim Amendments

To better describe the invention, claim 1 has been amended to recite a resin body *made from a thermoplastic molding resin* injection over-molded about the first bottle such that the opening in the distal end of the neck is exposed. Support for these amendments can be found in the specification (last paragraph on page 5 and last paragraph on page 7 in the specification as filed), and in the drawings. Claim 10 has been canceled without prejudice. In addition to the reasons submitted in the earlier response with respect to the structural differences yielded by injection molding (see rebuttal to Examiner's Response to Arguments below), Applicant submits that, for at least the following reasons, the rejections are overcome.

It is respectfully submitted that a resin body made from a thermoplastic molding resin injection over-molded on an article is structurally different from other types of plastic (e.g., casting resins and/or thermosetting resins) for at least two reasons. First, thermoplastic resins can be remelted and cooled numerous times without undergoing appreciable chemical change. Casting resins are generally two part resins that undergo an irreversible chemical reaction when the two parts are mixed. Once cured, casting resins are permanently hardened and cannot be remelted and reshaped with subsequent heating. Thermosetting resins once cured are also permanently hardened and cannot be remelted and reshaped. Both casting resins and thermosetting resins once cured will be damaged by subsequent heating.

Thermoplastic resins are impervious to solvents typically encountered, for example, in cosmetic formulas, perfumes, etc. (e.g., alcohol). While casting resins and thermosetting resins are irreversibly cured, they are generally not chemically inert with respect to solvents found in consumer products. Accordingly, casting resins and

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thermosetting resins are subject to discoloration, or worse, deterioration when exposed to solvents.

Claim Rejections - 35 U.S.C. 102

In the present Office Action, claims 1, 2, 7 and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Wallace (3,007,594) or MacDonald et al. (2,562,726). According to the Office Action, either Wallace or MacDonald et al. teach a container having a first thin-walled bottle with a neck extending from a storage portion, and a minimum wall thickness, and a molded over resin body having a maximum wall thickness at least three times the minimum wall thickness of the storage portion.

Wallace discloses a glass bottle enveloped by a foamed plastic coating of polystyrene. The plastic coating is formed by filling (presumably by pouring without pressure) a mold cavity with heat expansible plastic beads, and then applying heat to expand the beads. The plastic coating appears to be a thermosetting plastic.

Wallace does not disclose a resin body made from a *thermoplastic* molding resin. Wallace does not disclose a plastic coating injection over-molded about a bottle. Thus, Wallace fails to disclose all of the elements in the present claims as amended.

MacDonald et al. disclose an urn cast over a glass liner *without the use of heat and pressure* (col. 5, lines 11-12). Accordingly, MacDonald does not disclose a resin body made from a thermoplastic molding resin, and does not disclose injection molding. Thus, MacDonald et al. fails to disclose all of the elements in the present claims as amended.

A rejection under 35 U.S.C. 102(b) requires that each element of a pending claim be disclosed in a single prior art reference. Because neither the Wallace nor MacDonald et al. references disclose each of the elements as claimed, neither reference supports an anticipation rejection under 35 U.S.C. 102(b). Accordingly the rejection of claims 1, 2 and 7 under 35 U.S.C. 102(b) as being anticipated by Wallace (3,007,594) or MacDonald et al. (2,562,726) should be withdrawn.

In the present Action, Claims 1, 2, 4, 5 and 7-9 stand rejected under 35 U.S.C. 102(b) as being anticipated by Barriere (3,663,259).

According to the Office Action, the Barriere reference teaches a container having a first thin-walled bottle with a neck 2 extending from a storage portion, and a

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minimum wall thickness, a resin body 5 having a maximum wall thickness at least three times the minimum wall thickness of the storage portion. The Office Action further asserts that with respect to the over-molded outer resin, the method of injection molding does not impart any structure over the resin body of Barriere.

As an initial matter, Applicant respectfully disagrees with the Office Action assertion that injection molding does not impart any structure over the resin body of Barriere. For the reasons stated in the previous Response filed on November 14, 2004, injection molding does impart structural differences over cast resin bodies (e.g., different molecular level structure). The present Office Action fails to dispute this structural distinction with substantive arguments or information.

To better recite the invention, claim 1 has been amended to recite a resin body *made from a thermoplastic molding resin* injection over-molded about the first bottle such that at least the opening in the distal end of the neck is exposed. For at least the following reasons, it is respectfully submitted that the claims as amended are patentable over the cited references.

A rejection under 35 U.S.C. 102(b) requires that each element of a pending claim be disclosed in a single prior art reference. The Barriere reference fails to teach (or suggest) a resin body made from a thermoplastic molding resin and fails to teach (or suggest) a resin body injection over-molded about a first bottle. At best the Barriere reference teaches coating by dipping or casting in a liquid polyester resin (the state of the art for polyester resins at the time of the Barriere invention). There is nothing in the Barriere reference that teaches a thermoplastic resin body injection overmolded on a thin-walled bottle.

Because Barriere does not teach a thermoplastic resin body injection over-molded about a thin-walled bottle, Barriere does not teach each element of claim 1. The present invention as recited in claim 1 therefore distinguishes from and is patentable over the Barriere reference. Thus, with respect to claim 1 as amended, and claims 2, 4, 5 and 7-9 (which depend from and include all of the recitations of claim 1), the rejection under 35 U.S.C. 102(b) as being anticipated by Barriere (3,663,259) is traversed and should be withdrawn.

Claims 1, 2, 4, 5 and 7-9 stand rejected, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Barriere in view of Nohara or Wallace.

According to the Office Action Wallace teaches that it is known to the outer resin body by injection molding.

Applicant respectfully disagrees. Wallace does not teach or suggest injection molding. Wallace teaches filling a mold with heat expansible plastic beads. This is not injection molding. Furthermore, the claims as amended recite a thermoplastic resin. Neither Barriere nor Wallace teach or suggest a thermoplastic resin, therefore, the combination of the teachings would not yield the present article as claimed.

According to the Office Action, Nohara teaches that it is known in the art to provide the outer resin outer body [sic] by injection molding as shown in Fig. 5. The Examiner asserts that it would have been obvious to one of ordinary skill in the art to provide the outer body by injection molding in Barriere as taught by Nohara to provide an alternative method of making the outer layer.

Applicants respectfully disagree for at least the following reasons.

Combining the teachings of two references requires at least a suggestion that would motivate one make the combination. This is generally understood to be at least a suggestion that the combined teachings of the two references would yield a benefit or an advantage. The Examiner did not assert such a benefit or advantage, and there is in fact no benefit or advantage taught or suggested in either reference that would motivate one to combine the teachings of the two references. The two references in fact address different art areas. Barriere discloses coating a fully formed bottle. Nohara discloses injection over-molding to make a multilayer **pre-form** for the eventual production of a bottle by draw-blow forming. Thus, Nohara teaches injection over-molding of a pre-form of a bottle, not injection over-molding a resin body about a bottle. Since there is no suggestion in either reference that a benefit or advantage would be yielded by combining the references, there would be no motivation to combine these references. Because there would be no motivation to combine the references, the rejection of the claims based on the combination is not well taken and should be withdrawn.

In the unlikely event that one would be motivated to combine the teachings of the Barriere and Nohara references (as noted above, there would be no motivation to do so), combining the teachings would not yield the present invention as claimed. As noted, Barriere teaches coating a resin onto a bottle. Nohara teaches injection molding a resin outer layer *onto a resin pre-form*. The resulting multi-layer pre-form is subsequently draw-blow formed into a finished bottle. The Barriere reference coats a finished bottle, not a pre-form, and does not teach or suggest subsequent operations, such as draw-blow molding, to form a finished bottle because none are

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necessary. The coated bottle of Barriere is finished. The resulting products of the two operations are also radically different. The Barriere reference yields a finished glass bottle with a resin coating. The Nohara reference yields a multi-layer pre-form with a resin inner layer, a barrier layer and resin outer layer. There is no teaching or suggestion that this multi-layer pre-form or any of its individual layers would be suitable for use in coating a glass bottle. Thus, even if the teachings of Barriere were combined with the teachings of Nohara, one might arrive at injection molding a resin outer layer on a pre-form of a Barriere-like bottle, but one would not arrive at a resin coating on a finished bottle according to Barriere.

Because there would be no motivation to combine the Barriere and Nohara references, and/or because even if the teachings of Barriere and Nohara were combined one would not arrive at the present invention as claimed, the rejection of claims 1, 2, 4, 5 and 7-9 under 35 U.S.C. 103(a) as being unpatentable over Barriere in view of Nohara (4,646,925) is not well taken and should be withdrawn.

With respect to the foregoing argument, the Examiner responded that "one of ordinary skill in the art recognize that injection molding is well known and to use this particular method to facilitate the manufacture of the bottle is within one of skill in the art" [sic]. By failing to provide a reference or some other information that indicates that it is well known to inject thermoplastic resins over thin walled bottles, the Examiner has failed to meet the burden established in the MPEP for rejection of claims based on section 103(a). The Wallace reference does not disclose the use of thermoplastic or injection molding. None of the references provide any motivation to combine the teachings of Nohara with the teachings of Barriere. The Examiner merely states that "one of ordinary skill would recognize..."

Applicant respectfully disagrees. Articles of the type recited in the present claims have previously not been commercially available because those skilled in the art considered them unfeasible. It was believed that the high pressures and high temperatures involved would crush the thin walled bottle, particularly if the bottle was made of a brittle material like glass, or a malleable material like aluminum. For this reason, Barriere teaches casting or dipping the bottle, MacDonald teaches casting and Wallace teaches filling without injection. Nohara teaches injection molding, but uses a plastic insert, not a fragile bottle that would be crushed or collapse under heat and pressure. Furthermore, Nohara supports the insert internally during injection molding of the outer coating to prevent collapse of the internal structure (see Fig. 5). The present

article is made with a bottle or insert that is not supported internally during injection molding. All of these references teach away from the present invention as claimed.

In view of the above, the present claims are patentable over the cited prior art.

Rebuttal of Examiner's Response to Arguments

In section #8 in the Office Action, the Examiner takes the position that the limitation "a resin body injection over-molded" do not [sic] impart any structure over the container of Barriere. However, this position in the Office Action is not supported with evidence. In fact, the Examiner fails to state precisely how the articles are the same. Applicant's earlier response clearly indicated why the invention as recited is structurally different, i.e., different molecular level structure imparted by injection molding. The Examiner failed to contradict Applicant's position that the molecular level structure is different. Accordingly, Applicant presumes that the Examiner is conceding that Applicant's position with respect to molecular level structure is correct. If the Examiner is conceding that the molecular level structure is different, then the Examiner's position that the limitation does not impart structure over the container of Barriere is incorrect and should be reversed.

Applicant's earlier response also pointed out that one skilled in the art of molding would recognize the recitation of injection molding as a structural difference. The Examiner has failed to rebut this argument.

If the Examiner has any evidence or information indicating that the caste resin body of Barriere has the same molecular level structure as the injection molded resin body claimed by the present application, it would be gratefully appreciated if the Examiner could provide the evidence or information to Applicant.

The claims as amended particularly distinguish structurally over the cited prior art references. None of the cited prior art references teach or suggest a resin body made from a thermoplastic resin injection over-molded onto a bottle.

Also, as noted in Applicant's earlier response, the U.S. Patent Office has recognized distinctions that appear to be product-by-process but are actually structurally different by granting patent claims with such recitals. See for example, Wallace 3,007,594 and Nohara 4,646,925, describing what at first glance could be construed as identical products. Nohara, issued almost 30 years after Wallace, includes as a

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recitation "...portions are integrally formed of a thermoplastic polyester...". While this appears to be product-by-process language, it is more clearly understood by those skilled in the art as structurally distinguishing the component from non-integrally formed components.

In view of the amendments and remarks above, it is respectfully submitted that the present invention is patentable over the cited prior art. Early and favorable consideration is respectfully requested. Applicants reserve the right to file division, continuation and continuation-in-part applications to prosecute any inventions or species.

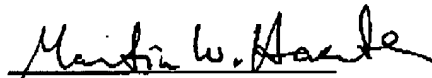
Submitted concurrently herewith is a Petition for Extension of Time to extend the time to respond by three months from April 27, 2004 to July 27, 2004. The Petition includes authorization for the Commissioner to charge the fee for extension to Deposit Account No. 05-1320.

If there are any other issues remaining which the Examiner believes could be resolved through telephone contact, the Examiner is respectfully encouraged to call the undersigned at the telephone number indicated below.

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